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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,590	09/30/2003	Kerry Sellen	1DATA.111A	9932
29995 7590 03/17/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER				
LE, UYEN CHAU N				
ART UNIT		PAPER NUMBER		
2887				
NOTIFICATION DATE		DELIVERY MODE		
03/17/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/675,590

Applicant(s)

SELLEN ET AL.

Examiner

Uyen-Chau N. Le

Art Unit

2887

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-98 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-98 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/DE)
Paper No(s)/Mail Date 05/27/2004; 08/16/2005; 02/15/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Objections

1. Claims 46, 59, 63, 75, 79, 90 and 94 are objected to because of the following informalities:

Re claim 46, line 2: Substitute "it authorizes" with -- authorization -- because it is not clear what "it" is referring to.

Re claim 59, line 3: Substitute "capable of" with -- configured for -- because "capable of" is not clear whether or not the system actually performs the recited functions.

Re claim 63, line 2: Substitute "it authorizes" with -- authorization -- because it is not clear what "it" is referring to.

Re claim 75, line 3: Substitute "capable of" with -- configured for -- because "capable of" is not clear whether or not the system actually performs the recited functions.

Re claim 79, line 2: Substitute "it authorizes" with -- authorization -- because it is not clear what "it" is referring to.

Re claim 90, line 3: Substitute "capable of" with -- configured for -- because "capable of" is not clear whether or not the system actually performs the recited functions.

Re claim 94, line 2: Substitute "it authorizes" with -- authorization -- because it is not clear what "it" is referring to.

Appropriate correction is required.

Obviousness-Type Double Patenting

2. Claims 1, 33, 50, 67 and 83 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, 13, 23, 34 and 47 of U.S. Patent No. US 7108174 B2 (hereinafter '174). Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims 1, 33, 50, 67 and 83 of the present application and the claims 1, 7, 13, 23, 34 and 47 of the patent '174 are almost identical. The only difference between the present claimed invention and the '174 patent is that the present claimed invention is a broader recitation of the '174 patent.

Claims 1, 33 and 50 of the present application recite a system and method of electronically processing a corporate check received at a merchant location wherein the merchant location is associated with a subscribing merchant comprising: "receiving a check at the merchant location; *scanning the received check* at the merchant location; *determining* at the merchant location whether the scanned check is a corporate check or a non-corporate check based on the presence or absence of an auxiliary on-us field on the check's magnetic ink character recognition (MICR) line; *communicating information about the scanned check* from the merchant location to a check processing service wherein the information about the scanned check includes an indicator indicative of the *presence or absence of the auxiliary on-us field*; and *determining at the check-processing service, whether to process the information about the scanned check electronically as a corporate check or a non- corporate check based at least partly on the auxiliary on-us field indicator.*" whereby claims 1, 7, 13, 23 of the patent to '174 recites a system and method of electronically processing a check comprising: "*scanning a check* received by a merchant at a merchant location to obtain information about the check

that facilitates electronic processing of the check wherein the information about the check includes a magnetic ink character recognition (MICR) line imprinted on the check; *determining* that the *check is a corporate check* when the *MICR line comprises an auxiliary on-us field*; indicating that the check is the corporate check when the auxiliary on-us field is present; and *communicating* the indication and the *information about the check* to a check processing service that authorizes or declines a check transaction associated with the check; *wherein the check processing service: applies selected corporate rules to the check transaction when the indication indicates that the check is the corporate check; notifies the merchant to process the check as a paper check when the check transaction fails the corporate rules; performs a risk assessment of the check transaction to authorize or decline the check transaction when the check transaction passes the corporate rules; and processes the check as a cash concentration disbursement (CCD) transaction via an automated clearing house (ACH) when the check is authorized.*"

Claim 67 of the present application recite a system for processing a financial transaction involving a merchant comprising: "a receiving component that *receives information about the financial transaction* wherein the information allows at least a portion of subsequent processing of the financial transaction to be performed electronically and wherein *the information includes a field that determines whether the financial transaction is a corporate type or a non-corporate type*; and a *financial transaction processing service linked to the receiving component wherein the processing service is configured to allow determination of whether the, financial transaction should be processed electronically as a corporate type or a non- corporate type transaction based at least partly on the field.*" whereby claim 34 of the patent to '174 recites a

system and method of electronically processing a check comprising: "An apparatus for conducting a financial transaction, comprising: an electronic device that *obtains information about a financial transaction* wherein the electronic device is configured to capture a field associated with the information and wherein the electronic device is associated with a merchant involved in the financial transaction; and a processor configured to induce the capture of the field and to detect the presence of the field, wherein the processor *determines whether the financial transaction is a corporate type transaction or a non-corporate type transaction based on the presence or absence of the field, and the processor provides an indication that the financial transaction is the corporate type transaction when the field is present, wherein the financial transaction comprises a check transaction and wherein a check processing service: applies selected corporate rules to the check transaction when the indication indicates that the check transaction is the corporate type transaction; notifies a merchant to process the check transaction as a paper check transaction when the check transaction fails the corporate rules; performs a risk assessment of the check transaction to authorize or decline the check transaction when the check transaction passes the corporate rules; and processes the check transaction as a cash concentration disbursement (CCD) transaction via an automated clearing house (ACH) when the check transaction is authorized.*"

Claim 83 of the present application recite a system for processing a financial transaction involving a merchant comprising: "a *first means for obtaining information about the financial transaction* wherein the information facilitates *determination of whether the financial transaction is a corporate type or a non-corporate type transaction*; and a *second means for determining whether the financial transaction should be processed electronically as a*

corporate type or a non-corporate type transaction based at least partly on the information about the financial transaction.” whereby claim 47 of the patent to ‘174 recites a system and method of electronically processing a check comprising: “means for reading magnetic ink character recognition (MICR) information from a check associated with a check transaction; means for determining that the check transaction is a corporate type transaction when the MICR information includes an auxiliary on-us field; means for indicating that the check transaction is the corporate type transaction when the auxiliary on-us field is present; and means for communicating the indication and the information about the check transaction to a check processing service that authorizes or declines the check transaction, the check processing service comprising: means for applying selected corporate rules to the check transaction when the indication indicates that the check is a corporate check; means for notifying a merchant to process the check as a paper check when the check transaction fails the corporate rules; means for performing a risk assessment of the check transaction to authorize or decline the check transaction when the check transaction passes the corporate rules; and means for processing the check transaction as a cash concentration disbursement (CCD) transaction via an automated clearing house (ACH) when the check transaction is authorized.”

Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teaching of claims 1, 7, 13, 23, 34 and 47 of the patent ‘174 as a general teaching for having a system and method of conducting a financial transaction with the same functions as claimed by the present application. The instant claims obviously encompass the patented claims and differ only in terminology. To

the extent that the instant claim is broaden and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

The obviousness-type double patenting rejection is a judicially established doctrine base upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-2, 4-7, 13-18, 20-23, 29-36, 38-40, 42-43, 49-57, 59-60, 66-73, 75-76, 81-88, 90-91 and 97-98 are rejected under 35 U.S.C. 102(e) as being anticipated by Koakutsu (US 6902105 B2 - cited by the Applicant).

Re claims 1-2, 4-7, 13-18, 20-23, 29-36, 38-40, 42-43, 49-57, 59-60, 66-73, 75-76, 81-88, 90-91 and 97-98: Koakutsu discloses a method of electronically processing a corporate check received at a merchant location wherein the merchant location is associated with a subscribing merchant, the method comprising:

receiving a check at the merchant location; scanning the received check at the merchant location (fig. 7);

determining at the merchant location whether the scanned check is a corporate check or a non-corporate check based on the presence or absence of an auxiliary on-us field on the check's magnetic ink character recognition (MICR) line (col. 12, lines 20-30);

communicating information about the scanned check from the merchant location to a check processing service wherein the information about the scanned check includes an indicator indicative of the presence or absence of the auxiliary on-us field (i.e., setting the appropriate reading/scanning parameters) (col. 12, lines 30+); and

determining at the check processing service, whether to process the information about the scanned check electronically as a corporate check or a non-corporate check based at least partly on the auxiliary on-us field indicator (fig. 16; col. 12, lines 14-45).

further comprising determining at the check processing service, whether to authorize or decline the scanned check (col. 12, lines 20+).

wherein determining whether to authorize or decline the scanned check as a corporate check comprises determining whether the subscribing merchant is set up to conduct corporate check transactions (fig. 5; steps S508-S510).

wherein the scanned check is processed as a non-corporate check if the subscribing merchant is not set up to conduct corporate check transactions (fig. 16; col. 12, lines 14-45).

wherein determining whether to authorize or decline the scanned check as a corporate check further comprises determining whether the information about the scanned check includes the indicator indicating the presence of the auxiliary on-us field on the scanned check (col. 12, lines 20-30).

wherein the scanned check is processed as a non-corporate check if the indicator does not indicate the presence of the auxiliary on-us field on the scanned check (col. 12, lines 29-30).

further comprising inducing imaging of the check upon determination that the check is a corporate check; wherein a full image of the check is obtained; wherein an image of at least a portion of the check is obtained; further comprising retaining the check image at the check processing service upon determination that the check is to be processed as a corporate check (figs. 13 and 16; col. 11, lines 31+ and col. 12, lines 14-45).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 3, 19, 41, 58, 74 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koakutsu in view of Repak (US 20030229586 A1 - cited by the Applicant). The teachings of Koakutsu have been discussed above.

Re claims 3, 19, 41, 58, 74 and 89: Koakutsu has been discussed above but is silent with respect to allows the check processing service to process the check as a cash concentration disbursement (CCD) transaction via an automated clearing house (ACH) if the check is a corporate check.

Repak teaches an Automated Clearing House (ACH) file 135 typically comprises a standard entry class (SEC) code including CCD (cash concentration and disbursement) used for corporate payment applications that provide the ability to collect and disburse funds and information between companies, CTX (commercial trade exchange) used for corporate payment applications originated by an Originator to pay or collect an obligation of such Originator and destined for the account of another organization (paragraphs [0006] and [0021]).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the cash concentration and disbursement method of Repak into the system as taught by Koakutsu in order to provide Koakutsu with a time consumption system wherein in no further action is required (e.g., generating a credit reversal and posted to the account for authorization), thus the user can get the cash instantaneously.

8. Claims 8-11, 24-27, 37, 44-47, 61-64, 77-80 and 92-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koakutsu in view of Templeton et al US 5679940 A - cited by the Applicant). The teachings of Koakutsu have been discussed above.

Re claims 8-11, 24-27, 37, 44-47, 61-64, 77-80 and 92-95: Koakutsu has been discussed above but is silent with respect to determining whether to authorize or decline the scanned check includes performing a risk assessment of the check transaction, wherein determining whether to authorize or decline the scanned check depends at least to some degree on a level of service subscribed by the merchant, wherein the level of service includes the check processing service guaranteeing checks authorization thereby assuming risks associated with such checks, wherein the level of service includes the check processing service purchasing checks from the merchant thereby assuming risks associated with such checks, wherein the device comprises a telephone based device configured to perform a financial transaction, respectively.

Templeton et al teaches a transaction system comprises determining whether to authorize or decline the scanned check includes performing a risk assessment of the check transaction, wherein determining whether to authorize or decline the scanned check depends at least to some degree on a level of service subscribed by the merchant, wherein the level of service includes the check processing service guaranteeing checks authorization thereby assuming risks associated

with such checks, wherein the level of service includes the check processing service purchasing checks from the merchant thereby assuming risks associated with such checks (col. 11, lines 9+; col. 14, lines 1-27; col. 19, lines 16-34; col. 28, lines 12+); wherein the device comprises a telephone based device configured to perform a financial transaction (figs. 3 and 4; col. 16, lines 47+ and col. 17, lines 20+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Templeton et al into the system as taught by Koakutsu in order to provide Koakutsu/Repak with a more secure system in which risk assessment system is configured for making a more complete and accurate evaluation of whether to approve or decline a check transaction (i.e., the preferred risk assessment system uses a profitability coring model to evaluate the overall profitability of a transaction and utilizes the result as a key indicator in determining whether to approve or decline a transaction), and therefore an obvious expedient.

9. Claims 12, 28, 48, 65 and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koakutsu in view of Lowery (US 6189785 B1). The teachings of Koakutsu have been discussed above.

Re claims 12, 28, 48, 65 and 96: Koakutsu has been discussed above but is silent with respect to providing a receipt at the merchant location for the received check, wherein the receipt includes language specific for the corporate or non-corporate check depending on the determination of the type of the scanned check.

Lowery teaches the point of sale printer may be any type of computer printer capable of generating an authorization receipt recording the identification of the merchant, the check 110 information, sale information, and the transaction result (col. 6, lines 12-16).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Lowery into the system as taught by Koakutsu in order to provide Koakutsu with an alternative means for transactions verification (i.e., the transaction data can be verified ready via the information printed on the receipt, which including check information, purchase information, etc.), and therefore an obvious expedient.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven S. Paik can be reached on 571-272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Uyen-Chau N. Le/
Primary Examiner, Art Unit 2887

March 2, 2008